

REMARKS

Claims 1, 5 and 9-28 are pending in this application. By this amendment, claims 2-4 and 6-8 are cancelled, the Specification, drawing Fig. 2, and claims 1, 5, and 9-12 are amended and claims 13-28 are added. Reconsideration of the application in view of the following marks is respectfully solicited.

I. The Restriction Requirement Should Be Withdrawn

Items 1-4 of the Office Action request restriction of the claims between Group I, comprising claims 1-8, and drawn to a web cleaning apparatus, and Group II, comprising claims 9-12, and drawn to a method of cleaning a web. On June 24, 2003, Examiner El-Arini presented applicants with a telephone restriction, at which time applicant's representative provisionally elected Group I, claims 1-8, with traverse. Applicant confirms this election with traverse for the following grounds.

Item 2 of the Office Action correctly identify Groups I and II as an apparatus and a process performed using that apparatus. Item 2 also correctly identifies the grounds for which restriction can be required in this case. However, applicant respectfully submits that, even if the grounds for restriction with respect to claims 1-12 as filed were proper, the grounds for restriction with respect to claims 1, 5 and 9-12 as amended are no longer proper.

As presently pending, Group I comprises claims 1, 5 and 13-26, while Group II comprises claims 9-12, 27 and 28. Each of claims 1, 5 and 13-26 sets forth a web cleaning apparatus that includes at least one web buffing roll that comprises a hollow core and a jacket positioned tightly about the hollow core, while the hollow core includes an outer surface and stub shafts and the jacket has a soft outer surface and a profusion of protruding fibers. Claims 9-12, 27 and 28 likewise recite methods for cleaning a surface of a web using a roller having a hollow core and a jacket positioned tightly about the hollow core with the hollow core having an outer surface and stub shafts and the jacket having an outer surface having a profusion of protruding fibers.

As noted in Item 2, the inventions are distinct only if the process is claimed can be practiced by another, materially different apparatus or by hand, or the apparatus' claim can be used to practice another and materially different process. As interpreted by the Board of Patent Appeals and Interferences and the Federal Circuit, the term "another, materially different apparatus" and the term "another and materially different process" require identifying an

apparatus that does not fall within the scope of the apparatus claims but which nevertheless can be used to practice the method as claimed and a method which falls outside of the scope of the method claims but nonetheless can be practiced using the apparatus as claimed, respectively.

In Item 2, the another and materially different apparatus identified in the grounds for restriction is one without “a first buffing roll and a second buffing roll”, while the another and materially different process is one which omits “the step of fabricating a core from a thin-walled cylinder”. With respect to the first grounds for restriction, applicant’s first note that claim 5, unlike claim 1, requires only a single web buffing roll. Thus, with respect to claim 5, an apparatus which omits a second buffing roll is still within the scope of claim 5. Furthermore, claims 1 and 9 both set forth first and second buffing rolls, while claims 5 and 12 both set forth a single buffing roll. Thus, any process which omits both of the first and second buffing rolls would not be within the scope of claims 1 and 9-12. Thus, any such device, while “materially different” than the claims of Group I, is not “another” device usable to practice the processes of Group II, as such an apparatus, even if performing the method steps recited in claims 9-12, 27 and 28, would not be within the scope of such claims.

Similarly, since none of claims 9-12, 27 and 28 currently recite the step of “fabricating a core from a thin-walled cylinder”, omitting such a step no longer creates a materially different process, as such a process omitting such a step now remains within the scope of claims 9-12, 27 and 28.

Accordingly, regardless of whether the grounds for restriction were previously proper, claims 1, 5 and 9-12 as amended and claims 13-28 as added render such grounds for restriction moot. Accordingly, applicant respectfully requests the grounds for restriction and the restriction requirement itself be withdrawn and claims 9-12, 27 and 28 be rejoined with claims 1, 5 and 13-26.

II. Informalities in the Specification

Items 5-7 object to the Specification and Drawings for containing certain informalities. Applicant respectfully submits the above-outlined amendments to paragraphs 13 and 15-17 and revised Fig. 2 as set forth in the attached Request for Approval of Drawing Corrections fully obviates the grounds for objecting to the Specification and Drawings. Withdrawal of the objections to the Specification and Drawings set forth in Items 5-7 are respectfully solicited.

III. Rejections Under 35 U.S.C. § 112

Items 8 and 9 reject claims 1-8 under 35 U.S.C. § 112 second paragraph in view of various informalities identified in Item 9. Applicant respectfully submits the above-outlined amendments to claims 1, 5 and 9-12 fully obviate the grounds for rejection of claims 1-8 set forth in Item 9. Withdrawal of the rejection of claims 1 and 5 under 35 U.S.C. § 112 second paragraph are respectfully solicited.

IV. Rejections Under 35 U.S.C. § 103

Items 10-12 reject claims 1-8 under 35 U.S.C. § 103(a) as unpatentable over the alleged “admitted state of the prior art” (ASPA) in view of U.S. Patent No. 1,071,519 to Hanish and applicant’s submitted product information from Edward H. Best & Co. (Best). The rejection is respectfully traversed.

With respect to claims 1, 9-11, 13-15 and 19-22, applicant respectfully submits that neither the ASPA nor Hanish provide any teaching disclosure or suggestion for a jacket which is positioned tightly about the outer surface and clamped between opposed end caps and ends of the hollow core, as set forth in claims 1, 9-15, 19-23, 27 and 28.

Furthermore, with respect to claims 13, 16, 20 and 24, Hanish clearly shows that the polishing cloth 7 is wound upon the bars 10 such that an unused portion is around one of the bars 10, the usable portion extends through a slot in the drum, extends about the surface of the drum, extends back through the slot into the interior of the drum and is taken up by one of the other bars 10. Thus, in Hanish, the polishing cloth does not extend continuously around the outer surface, in that there is a discontinuity in the polishing cloth at the slot.

With respect to claims 14, 17, 21, and 25, Hanish shows that the diameter of the drum, as shown in Fig. 2 is on the same order as the axial length of the drum, as shown in Fig. 1. While patent drawings are not normally considered to be of the scale, Hanish clearly shows in Fig. 1 that the diameter of the drum shown in Fig. 2 is to scale with the diameter of the drum shown in Fig. 1. Thus, the axial length of the drum in Fig. 1, and the diameter of the drum shown in Fig. 2 are of similar scale such that their relative dimensions can be compared. In particular, even rough-measuring shows that the axial length of the drum in Hanish is about 1.2 times the diameter of Hanish’s drum, which applicant respectfully submits is not substantially greater than the diameter of the drum, in contrast to the features set forth in claims 14, 18, 21 and 25.

With respect to claims 15, 18, 22 and 26, Hanish clearly sets forth, at page 2, lines 40-47, that the polishing cloth will become worn. Clearly, such wear can only occur because of contact between the polishing cloth and the plane surfaces, such as moving picture films, which are being cleaned and polished by the polishing cloth. As such, Hanish cannot teach, disclose or suggest that the profusion of protruding fibers do not contact the web, as set forth in these claims. Furthermore, neither the ASPA nor Best can provide such teaching. Furthermore, because Hanish clearly expects the polishing cloth to contact the surface being cleaned, and thus provides a method for replacing the worn cloth with new cloth, Hanish clearly teaches away from having a non-contact interaction as set forth in these claims.

With respect to claims 5 and 23, applicant respectfully submits that neither the ASPA nor Hanish teach, disclose or suggest a hollow core having a core surface and separate stub shafts on which the web buffing roll rotates as set forth in these claims. Rather, Hanish clearly shows a pair of bearing sleeves 4 which are integrally formed with the spokes 5 such that the drum, comprising the circumferential surface or perimeter to, the spokes 5 and the bearing sleeves 4 form a single integral or unitary structure. In contrast, claims 5 and 23 set forth at the hollow core has both a core surface and separate stub shafts on which the web buffing roll rotates. Applicant respectfully submits that neither the ASPA nor Hanish provide any teaching, disclosure or suggestion for these features of claims 5 and 23.

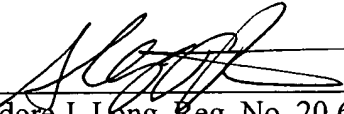
For at least the reasons outlined above, applicant respectfully submits that the combination of the ASPA, Hanish and Best fails to teach, disclose or suggest all of the features recited in claims 1, 5 and 9-28. Thus, the combination of the ASPA, Hanish and Best fails to render obvious the subject matter of claims 1, 5 and 9-28 under 35 U.S.C. § 103(a). Withdrawal of the rejection of claims 1 and 5 as unpatentable over the combination of the ASPA, Hanish and Best is respectfully solicited.

V. Conclusion

For at least the reasons outlined above, applicant respectfully submits the application is in condition for allowance. Favorable consideration and prompt allowance of claims 1, 5 and 9-28 is respectfully solicited.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



Theodore J. Long, Reg. No. 20,648
Stephen J. Roe, Reg. No. 35,463
Attorney for Applicant
Lathrop & Clark LLP
740 Regent Street, Suite 400
P.O. Box 1507
Madison, Wisconsin 53701_1507
(608) 257_7766

amdt.res